



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/674,877	01/02/01	HOEFLE	G 2727-127

RONALD R SANTUCCI  
PITNEY HARDIN KIPP & SZUCH  
20TH FLOOR  
711 THIRD AVENUE  
NEW YORK NY 10017

HM12/0830

EXAMINER

AULAKH, C

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 08/30/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/674,877

Applicant(s)

Hoeffle, G. et al.

Examiner

CHARANJIT AULAKH

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### **DETAILED ACTION**

1. According to a preliminary amendment ( paper no. 5 ), filed on Jan. 2, 2001, the applicants have amended claims 6-12, 14, 15 and 17.

2. Claims 1-17 are now pending in the application.

### ***Claim Objections***

3. Claims 9-14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternative only. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6-16, the term “ characterized in “ is vague. The applicants are suggested to use the term “ wherein “.

In claims 1-17, when x-y represents -CH<sub>2</sub>CH-OP, it is not clear what is connected to the C(CH<sub>3</sub>)<sub>2</sub>C=O group. Is it O or CH ?

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In claim 2 and 9-11, it is not clear what is meant by B in formula (3). Is it boron?

In claim 3, it is not clear whether Hal refers to only Br and I or Br and I are the preferred halogens since Cl and F are other known halogens.

In claims 9-14, the term "production" is vague. The applicants are suggested to use the term "preparation or preparing"

In claims 15-17, the terms "therapeutic agent and plant protecting agent" are vague and indefinite since it is not clear what is the intended purpose? It seems that the claims are directed to a pharmaceutical composition comprising compounds of claim 1. The applicants are suggested to direct the claims to pharmaceutical compositions or to a method of treating a particular disease state in a subject or as a herbicidal or pesticidal activity in case of protecting plants comprising administering a therapeutically effective amount of compounds of claim 1.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicolaou (Chem.--Eur. J. 3(12) 1971-1986, 1997, cited in the international search report).

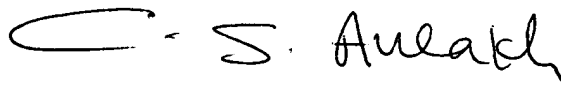
Nicolaou discloses total synthesis of oxazole- and cyclopropane-containing epothilone B analogues by the macrolactonization approach. The compounds no. 2 and 30-32 (see page 1973) disclosed by Nicolaou anticipate the instant claims when X-Y represent CH<sub>2</sub>CHOP and R<sub>2</sub> represents a monocyclic heteroaryl group in the instant compounds of formula (6).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on " Monday-Thursday " from 7:30 A.M. to 6:00 P.M.

If the attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Jyothsna Venkat, can be reached on (703) 308-2439. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's receptionist whose telephone number is (703) 308-1235.



CHARANJIT S. AULAKH

PRIMARY EXAMINER